

### **REMARKS**

Receipt of the office action mailed July 6, 2007 is acknowledged. Claims 1-20 are pending in the application. New claims 21-23 are added. Support for new claims 21-23 can be found on paragraphs 3-5 on page 8 and paragraphs 1-2 on page 9 of the specification. Claims 1-10 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,143,425 (Tanaka).

Applicant respectfully submits that the office action is incomplete. The office action notes on the summary sheet that claims 1-10 are pending and rejected. However, claims 1-20 are pending in the application by virtue of the Preliminary Amendment filed April 15, 2005. Applicant respectfully submits that claims 11-20 are allowable. Should the examiner feel that claims 11-20 are not in condition for allowance, Applicant requests that a new, non-final office action be issued setting forth the reasons why claims 11-20 are not patentable.<sup>1</sup> Applicant has no notice regarding the basis of the rejection, and Applicant therefore cannot respond. Nevertheless, in an effort to promote efficient prosecution, the Applicant has provided the following response to the rejections of claims 1-10.

As amended, each of claims 1, 2 and 3 related to a rolling bearing sized for use in a swing arm of a hard disk drive, and positively recite the rolling bearing having a chromium content of 8.00 to 9.50 wt%. By comparison, Tanaka teaches a rolling bearing having a chromium content of 10.0 wt% to 22 wt%. *See* Tanaka, col. 11, lines 16-58. Tanaka does not teach or suggest the chromium content being in the claimed range.

Moreover, Tanaka teaches away from lowering the chromium content below 10 wt%. According to Tanaka, "Cr is the most important element to provide steel with corrosion resistance, but if the content of Cr is less than 10.0 wt%, then good corrosion resistance cannot be provided." Tanaka, col. 11, lines 16-18. Good corrosion resistance is a main object of Tanaka. *See generally* Tanaka, col. 4, lines 46-67 to col. 5, lines 1-27. Thus, Tanaka explicitly teaches away from using a rolling bearing with a chromium content of less

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<sup>1</sup> "Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated . . ." MPEP § 707.07(d).

than 10 wt%. Accordingly, there is no motivation to lower the chromium content of Tanaka below 10 wt%.

Furthermore, there is no motivation to modify Tanaka to include the claimed chromium content because the modification would destroy a principal functionality of the reference. Tanaka explicitly discloses the objects of the invention are to “provide a rolling bearing . . . having excellent corrosion resistance . . .” Tanaka, col. 4, lines 49-52 to col. 5, lines 1-27. Tanaka further discloses without a chromium level of at least 10 wt% the rolling bearings would not have good corrosion resistance. *See* Tanaka, col. 11, lines 16-18.

The motivation to modify Tanaka can only be found by engaging in impermissible hindsight and using the Applicant’s disclosure as a template. The claimed invention solves the technical problem of reducing eutectic carbide size by reducing the amount of carbon and chromium. Specification at first full paragraph of page 5. By comparison, Tanaka limits eutectic carbide size by adding nitrogen and decreasing the amount of carbon. Tanaka, col. 11 lines 2-14 and col. 12, lines 60-64. There is no motivation to reduce the chromium content in Tanaka because the composition of Tanaka successfully reduces the eutectic carbide size without lowering the chromium content. Therefore, there is no motivation to modify Tanaka by lowering the chromium content to the claimed range. Accordingly, no *prima facie* case of obviousness can be established based on the cited reference. Applicant respectfully submits that the rejection of claims 1, 2 and 3 be withdrawn.

Claims 4, 6, 9, 10, 13, 14, 16, 20, and 21 depend from claim 1. Claims 7, 11, 15, 18, and 22 depend from claim 2. Claims 8, 12, 17, 19, and 23 depend from claim 3. As shown above, independent claims 1, 2, and 3 are allowable. Therefore, dependent claims 4 and 6-23 are also allowable.

Claim 5 relates to a material for a rolling bearing, and positively recites a chromium content of 8.00 to 9.50 wt%. As noted above, Tanaka does not disclose or suggest a rolling bearing with a chromium content of less than 10 wt%. Rather, Tanaka teaches a chromium content of 10.0 wt% to 22 wt%. *See* Tanaka col. 11 lines 16-58.

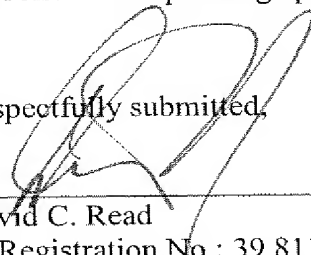
Moreover, as outlined above in reference to claims 1, 2, and 3, Tanaka teaches away from lowering the chromium content below 10 wt%, there is no motivation to modify Tanaka

to include the claimed chromium content because the modification would destroy the principal functionality of the reference, and any motivation to modify Tanaka can only be found by using impermissible hindsight. Therefore, claim 5 is also allowable.

In view of the above arguments, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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